THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant(s):	Mark Beckmann
Appl. No.:	10/522,345
Conf. No.:	6320
Filed:	March 10, 2005
Title:	METHOD AND DATA SYSTEM FOR CONNECTION A WIRELESS LOCAL NETWORK TO A UMTS TERMINAL STATION
Art Unit:	2617
Examiner:	N. Patel
Docket No.:	112740-1051

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' APPEAL BRIEF

Sir:

Appellants submit this Appeal Brief in support of the Notice of Appeal filed on December 17, 2007. This Appeal is taken from the Notice of Panel Decision from Pre-Appeal Brief Review dated February 15, 2008 and the Final Rejection dated September 17, 2007.

I. REAL PARTY IN INTEREST

The real party in interest for the above-identified patent application on Appeal is Siemens Aktiengesellschaft by virtue of an Assignment dated April 8, 2005 and recorded at reel 015875, frame 0219 in the United States Patent and Trademark Office.

II. RELATED APPEALS AND INTERFERENCES

Appellants' legal representative and the Assignee of the above-identified patent application do not know of any prior or pending appeals, interferences or judicial proceedings which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision with respect to the above-identified Appeal.

III. STATUS OF CLAIMS

Claims 1-15 are canceled, and claims 16-30 have been rejected in the Office Action. Claims 16-30 are therefore pending in this application. Therefore, claims 16-30 are being appealed in this Brief. A copy of the appealed claims is included in the Claims Appendix.

IV. STATUS OF AMENDMENTS

A non-final Office Action was mailed April 4, 2207, and Appellants filed a reply on July 3, 2007. Subsequently, a final Office Action was mailed on September 17, 2007, to which Appellants filed a Notice of Appeal, Pre-Appeal Brief Request for Review and Pre-Appeal Brief on December 17, 2007. A Notice of Panel Decision from Pre-Appeal Brief Review was mailed February 15, 2008, from which Appellants filed this Appeal Brief. A copy of the Non-Final Office Action, Final Office Action and Notice of Panel Decision from Pre-Appeal Brief Review are attached as Exhibits A, B and C, respectively, in the Evidence Appendix.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A summary of the invention by way of reference to the specification and/or figures for each of the independent claims is provided as follows.

Independent claim 16 is directed to a method for connecting a wireless local network (WLAN) to a UMTS terminal station (ME) having USIM/USAT functionality, the method including monitoring activity of the wireless local network by the terminal station using an existing connection; transmitting at least one of a type and an identity number of the wireless local network to the terminal station following successful detection of local network activity; initiating a logical connection between the wireless local network and the terminal station; and polling specific subscriber data of the wireless local network for the logical connection. See, for example, paragraphs [0007]-[0011] and [0032]-[0033] of the specification; Figures 4 and 5.

Independent claim 23 is directed to a data system for connecting a wireless local network to a UMTS terminal station, including a wireless local network (WLAN); a UMTS terminal station (ME) having USIM/USAT functionality establishing a connection to the wireless local network; parts for monitoring activity of the wireless local network using the established connection, wherein the parts for monitoring are contained in the terminal station; parts for transmitting at least one of a type and an identity number of the wireless local network to the terminal station, the transmission occurring following successful detection of local network activity; parts for initiating a logical connection between the wireless local network and the terminal station; and parts for polling specific subscriber data of the wireless local network for the logical connection. See, for example, paragraphs [0017]-[0023] and [0032]-[0033] of the specification; Figure 4 and 5.

Independent claim 30 is directed to a UMTS terminal station having USIM/USAT functionality for establishing a connection to a wireless local network, including parts for monitoring activity of the wireless local network (WLAN) using an existing connection; parts for initiating transmission of at least one of a type and an identity number of the wireless local network to the terminal station (ME), the transmission occurring following successful detection of local network activity; parts for initiating a logical connection between the wireless local network and the terminal station; and parts for polling specific subscriber data

of the wireless local network for the logical connection. See, for example, paragraphs [0014] and [0017]-[0023] and [0032]-[0033] of the specification; Figures 4 and 5.

Although specification citations are given in accordance with C.F.R. 1.192(c), these reference numerals and citations are merely examples of where support may be found in the specification for the terms used in this section of the Brief. There is no intention to suggest in any way that the terms of the claims are limited to the examples in the specification. As demonstrated by the references numerals and citations, the claims are fully supported by the specification as required by law. However, it is improper under the law to read limitations from the specification into the claims. Pointing out specification support for the claim terminology as is done here to comply with rule 1.192(c) does not in any way limit the scope of the claims to those examples from which they find support. Nor does this exercise provide a mechanism for circumventing the law precluding reading limitations into the claims from the specification. In short, the references numerals and specification citations are not to be construed as claim limitations or in any way used to limit the scope of the claims.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 16-30 have been rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter.
2. Claims 16, 17, 19, 23, 24, 26 and 30 have been rejected under 35 USC 103(a) as unpatentable over Reddy (US Pub. No. 20040043791A1) in view of Lin (US Pat. No. 6,078,811).
3. Claims 18 and 25 have been rejected under 35 USC 103(a) as unpatentable over Reddy (US Pub. No. 20040043791A1) in view of Lin (US Pat. No. 6,078,811), further in view of Le (US Pat. No. 6,556,820).
4. Claims 20-22 and 27-29 have been rejected under 35 USC 103(a) as unpatentable over Reddy (US Pub. No. 20040043791A1) in view of Lin (US Pat. No. 6,078,811), further in view of 3GPP.

VII. ARGUMENT

A. LEGAL STANDARDS

1. Indefiniteness under 35 U.S.C. § 112, second paragraph

35 U.S.C. § 112, second paragraph states:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regarsds as his invention.

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). See also *In re Larsen*, No. 01-1092 (Fed. Cir. May 9, 2001) (unpublished) (The preamble of the *Larsen* claim recited only a hanger and a loop but the body of the claim positively recited a linear member. The court observed that the totality of all the limitations of the claim and their interaction with each other must be considered to ascertain the inventor's contribution to the art. Upon review of the claim in its entirety, the court concluded that the claim at issue apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112 paragraph 2.). See also *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004) ("The requirement to 'distinctly' claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles...Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite.").

Accordingly, a claim term that is not used or defined in the specification is not indefinite if the meaning of the claim term is discernible. *Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372, 69 USPQ2d 1996, 1999-2000 (Fed. Cir. 2004) (holding that the disputed claim term "surrender value protected investment credits" which was not defined or used in the specification was discernible and hence not indefinite because "the components of the term have well recognized meanings, which allow the reader to infer the meaning of the entire phrase with reasonable confidence").

If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph, would be appropriate. See *Morton Int'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993). See also MPEP 2173.02.

2. Obviousness under 35 U.S.C. § 103

The Federal Circuit has held that the legal determination of an obviousness rejection under 35 U.S.C. § 103 is:

> whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made...The foundational facts for the prima facie case of obviousness are: (1) the scope and content of the prior art; (2) the difference between the prior art and the claimed invention; and (3) the level of ordinary skill in the art...Moreover, objective indicia such as commercial success and long felt need are relevant to the determination of obviousness...Thus, each obviousness determination rests on its own facts.

In re Mayne, 41 U.S.P.Q. 2d 1451, 1453 (Fed. Cir. 1997).

In making this determination, the Patent Office has the initial burden of proving a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q. 2d 1955, 1956 (Fed. Cir. 1993). This burden may only be overcome "by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings." *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). "If the examination at the initial stage does not produce a prima facie case of unpatentability, then without more the Appellant is entitled to grant of the patent." *In re Oetiker*, 24 U.S.P.Q. 2d 1443, 1444 (Fed. Cir. 1992).

Moreover, the Patent Office must provide explicit reasons why the claimed invention is obvious in view of the prior art. The Supreme Court has emphasized that when formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. *KSR v. Teleflex*, 127 S. Ct. 1727 (2007).

Of course, references must be considered as a whole and those portions teaching against or away from the claimed invention must be considered. *Bausch & Lomb, Inc. v. Barnes-*

Hind/Hydrocurve Inc. , 796 F.2d 443 (Fed. Cir. 1986). "A prior art reference may be considered to teach away when a person of ordinary skill, upon reading the reference would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the Appellant." *Monarch Knitting Machinery Corp. v. Fukuhara Industrial Trading Co., Ltd.*, 139 F.3d 1009 (Fed. Cir. 1998), quoting, *In re Gurley*, 27 F.3d 551 (Fed. Cir. 1994).

B. THE CLAIMED INVENTION

The invention is directed to a system and method for connecting a wireless local network (WLAN) to a UMTS terminal station having USIM/USAT functionality that enables an exchange of WLAN-specific data between a UMTS terminal station and UICC, and permits a reliable connection setup and/or cleardown. A universal integrated circuit card (UICC) includes USIM and USAT. The UICC is connected to mobile equipment ME via a communication interface, and to a WLAN module WM via the communication interface. The flow of information between the UICC and ME occurs as follows. In step 1 shown in Figure 5, UICC directs the ME to monitor the "Active" status of the WLAN module WM. As a response 2 thereto, the ME sends a positive reception acknowledgement. Following occurrence of the event, that is to say the activation of the WLAN module WM as a result of a connection setup, the ME sends a response 3 containing the set parameters "Status = Active," "WLAN type/identity number = IEEE 802. 11" to the UICC. Before the actual polling of the WLAN-specific subscriber data can take place, a logical connection is initiated. This is implemented by the UICC with the request 4 and the set parameter "WLAN type/identity number = IEEE 802. 11" to the ME. As the response 5 the ME notifies the UICC via the set parameters "Status = OK" and "WLAN type/identity number = IEEE 802. 11," as an acknowledgement, that the request has been executed. Pursuant to the request 6, the UICC then interrogates the ME for the subscriber data of the WLAN module. The ME's response 7 contains the corresponding information: WLAN type/identity number, subscriber identification, password, secret key for data encryption and decryption, and Internet protocol address of the access node AP. In the case of the connection cleardown, that is to say the deactivation of the WLAN module, the ME sends a response 8 containing the set parameters "Status = Not Active," WLAN type/identity number = IEEE 802.11" to the UICC. To terminate the logical connection, the UICC sends the command 9

containing the set parameter "WLAN type/identity number = IEEE 802.11" to the ME. Finally, with the response 10 and the status field "OK," the ME notifies the UICC that the request has been executed and the logical connection terminated.

During an existing WLAN connection, that is to say between the steps 7 and 8, it is also possible that the UICC polls the temporary status of the WLAN module or, as the case may be, the WLAN-specific subscriber data at periodic intervals.

In the exemplary embodiment, it was assumed that the interface Cw is already implemented in such a way that it can support the data exchange via the interface Cu (compare Figure 4). Six USAT commands are defined for the purpose of implementing the data exchange between UICC and ME via the interface Cu:

1) Request the WLAN status: Pursuant to this command, the UICC can interrogate the ME for the status, such as "Active" or "Not Active" and type or identity number of the WLAN module, such asIEEE 802.11 or Hiperlan/2. As aresponse thereto, the ME is expected to send the corresponding information to the UICC via the command "terminal response." This command has the parameters status and WLAN type/identity number.

2) Request WLAN information: Pursuant to this command, the UICC can interrogate the ME for the WLAN-specific subscriber data of the WLAN module. As aresponse thereto, the ME is expected to send the corresponding information to the UICC via the command "terminal response." This command includes the parameters WLAN type/identity number, subscriber identification, password, secret key for data encryption and decryption, and Internet protocol address of the access node AP. This command corresponds to step 6 in Figure 5.

3) Connect WLAN: Pursuant to this command, the UICC can instruct the ME to initiate a logical connection to the WLAN module. As a response thereto, the ME is expected to notify the UICC via the command "terminal response" whether the request could be executed or not. This command has the parameter WLAN type/identity number and corresponds to step 4 in Figure 5.

4) Disconnect WLAN: Pursuant to this command, the UICC instructs the ME to terminate a logical connection with the WLAN module. As a response thereto the ME is expected to notify the UICC via the command "terminal response" whether the request could be executed or not. This command has the parameter WLAN type/identity number and corresponds to step 9 in Figure 5.

5) Set up an event list: Pursuant to this command, the UICC instructs the ME to monitor the status of the WLAN module; for example, "Active." As a direct response thereto, the ME is expected to send a "terminal response" containing "Accepted" or "Not accepted" to the UICC as an acknowledgement of the command. If the event occurs, that is to say in the case of the activation of the WLAN module, the ME is expected to send the corresponding information to the UICC via the command "terminal response." With this command, the WLAN-specific status parameters are added to the already existing parameter list; that is to say, event list. This command corresponds to step 1 in Figure 5.

6) Terminal response: This is a command by which the ME is expected to respond accordingly to the requests of the UICC concerning the above defined WLAN-specific commands. In the process, the WLAN-specific parameters (i.e., status, WLAN type/identity number, subscriber identification, password, secret key for data encryption and decryption, and Internet protocol address of the access node AP) are added to the already existing parameter list.

C. The rejection to claims 16-30 have been rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is improper.

The Final Office Action states that the term "polling specific subscriber data of the wireless local network for the logical connection" is indefinite, since it was allegedly unclear to the Office what the phrase meant, and further argued that the claim was "open ended."

Applicant submits that the claims are definite and particularly point out and distinctly claim the subject matter of the invention. Applicant cannot find any basis under MPEP 706.03(d) to which the present rejection is based upon. Applicant believes the meaning and scope of the claimed terminology is clear from a basic reading of the claim language, which will not be repeated for the purposes of this request. Regarding the "open ended" argument, Applicant can only find support for such a rejection in MPEP 2173.05(c) which relates to "numerical ranges and amount limitations" - Applicant has not provided any "numerical ranges" or "amounts" in the claims at issue. Additional support for the claimed terminology may be found, for example, in paragraphs [0013-15] of the amended specification. Applicant earnestly requests this rejection be reversed.

D. Claims 16, 17, 19, 23, 24, 26 and 30 have been rejected under 35 USC 103(a) as unpatentable over Reddy (US Pub. No. 20040043791A1) in view of Lin (US Pat. No. 6,078,811).

Specifically, the cited art, alone or in combination, fails to teach or suggest the features of "monitoring activity of the wireless local network by the terminal station using an existing connection; transmitting at least one of a type and an identity number of the wireless local network to the terminal station following successful detection of local network activity; initiating a logical connection between the wireless local network and the terminal station; and polling specific subscriber data of the wireless local network for the logical connection" as recited in claim 16, and similarly recited in claims 23 and 30.

Reddy discloses a mobile unit, wherein a removable storage module (SIM) has a unique storage module identity for storing information specific to a user, including an Internet Protocol (IP) address, a Public Land Mobile Network (PLMN), and International Mobile Subscriber Identity (IMSI) ([0030]). Reddy teaches that, upon successfully camping on a cell of a mobile network, an IP address is forwarded to an IP-based network capable of communicating with the mobile unit ([0032]). Alternately, the mobile unit has multi-network capabilities which allow it to communicate with an IP-based network and a cellular network at the same time ([0031]).

Under Reddy, the mobile unit does not monitor activity of the wireless local network using an existing connection as presently claimed. Instead, the mobile unit facilitates a cell search, and camps on the cell determined from the search ([0027]). It is clear from the disclosure that "searching" for a cell node is not equivalent to "monitoring activity of the wireless local network by the terminal station using an existing connection." To be sure, the search is conducted *because* the phone has no existing connection at the time of the search. Furthermore, to be able to "monitor" something, it has to exist (i.e. be recognized) in the first place.

Applicant cannot find where in Reddy it is disclosed that at least one of a type and an identity number of the wireless local network is transmitted to the terminal station following successful detection of local network activity. The Office Action alleges that the mere

recitation of "system information" encompasses *all* information, including the type and identity number of a wireless local network (page 2, second paragraph: "inherently discloses"). However, Applicant respectfully submits such examination is improper, as the specific kind of "system information" is not disclosed in Reddy. Furthermore, the reception of the "system information" in Reddy is disclosed as being transmitted from a node within a Radio Network Controller (RNC) (FIG. 1 (S3B), 6 (S22B), and 7 (S29B)) which is not considered a wireless local network. In FIG. 5, an "all-IP" network is disclosed, where the mobile unit connects to an IP network using the physical layer to set up the connection [0032: "provided the mobile unit is able to access the IP network at the physical layer"]. However, since the connection is occurring in the physical layer directly to an IP network, there is no "type" or "identity number" of a wireless local network that is transmitted at this point, since the IP address would have to be known to the user before the connection is even attempted.

Moreover, Reddy fails to teach or suggest the feature of initiating a logical connection between the wireless local network and the terminal station. The Office Action claims that the mobile unit connects to the Core Network 125 through UTRAN node 120 or with an IP address (page 7). However, this position confuses the *multiple different networks being connected by the mobile unit*. The UMTS core is certainly not a wireless local network. Reddy also fails to teach or suggest the feature of polling specific subscriber data of the wireless local network for the logical connection.

Lin fails to solve the deficiencies of Reddy, discussed above. Lin deals with the problem of "overflow" mobile terminals (i.e., more mobile terminals than user records that can be maintained at the visitor location registers) (see col. 5, lines 11-12). The process in steps S6.1-6.6 deals with the registration procedure for a telephone moving between registration areas (RA; see col. 6, lines 13-17). Under Lin, the described process deals with HLR information that is stored in the HLR for visitor location registers (VLR) for "overflow" terminals during registration (col. 6, lines 39-65). Thus an "existing connection" cannot be had until the registration is completed (col. 6, lines 13-18; col. 7, lines 4-11).

Additionally, there is no apparent reason why one having ordinary skill in the art would combine the references in the manner suggested in the Office Action. As argued above, Reddy teaches that, once a device has successfully camped on a cell of a mobile network, an IP address is forwarded to an IP-based network capable of communicating with the mobile unit

([0032]), or the mobile unit has multi-network capabilities which allow it to communicate with an IP-based network and a cellular network at the same time ([0031]). Again, Reddy, does not disclose that the mobile unit monitors activity of the wireless local network using an existing connection, and instead, the mobile unit facilitates a cell search, and camps on the cell determined from the search ([0027]). In contrast, Reddy discloses the updating of HLR databases for VLR's when devices are moving between registration areas. The Office Action fails to reconcile how the VLR's and "overflow" terminals would conceivably be utilized under the configuration of Reddy, which does not appear to utilize VLR's at all.

For at least these reasons, Appellant respectfully submits the rejections are improper and should be reversed. In light of the above, Appellant respectfully submit that independent claims 16, 27 and 30, and all claims depending directly or indirectly therefrom, are allowable.

E. The rejections to claims 18 and 25 have been rejected under 35 USC 103(a) as unpatentable over Reddy (US Pub. No. 20040043791A1) in view of Lin (US Pat. No. 6,078,811), further in view of Le (US Pat. No. 6,556,820); Claims 20-22 and 27-29 have been rejected under 35 USC 103(a) as unpatentable over Reddy (US Pub. No. 20040043791A1) in view of Lin (US Pat. No. 6,078,811), further in view of 3GPP are improper.

The rejections are respectfully traversed for the same reasons presented in the arguments above.

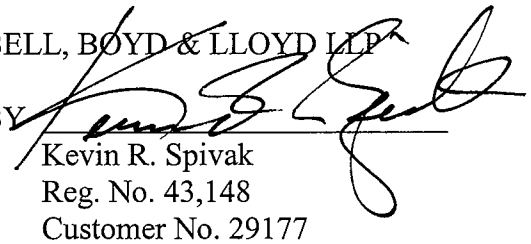
VIII. CONCLUSION

Appellants respectfully submit that the Examiner has failed to establish that the claims are indefinite under 35 U.S.C. § 112, second paragraph, and that the applied references disclose each and every limitation of the claimed invention under 35 U.S.C. § 103 with respect to the rejection of Claims 16-30. Accordingly, Appellants respectfully submit that the anticipation rejection is erroneous in law and in fact and should therefore be reversed by this Board.

The Director is authorized to charge any additional fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 112740-1051 on the account statement.

Respectfully submitted,

BELL, BOYD & LLOYD LLP

BY 

Kevin R. Spivak
Reg. No. 43,148
Customer No. 29177
Phone: 202-466-6300

Dated: March 17, 2008

CLAIMS APPENDIX

PENDING CLAIMS ON APPEAL OF U.S. PATENT APPLICATION SERIAL NO. 10/522,345

Claims 1-15. (canceled)

Claim 16. A method for connecting a wireless local network to a UMTS terminal station having USIM/USAT functionality, the method comprising:

monitoring activity of the wireless local network by the terminal station using an existing connection;

transmitting at least one of a type and an identity number of the wireless local network to the terminal station following successful detection of local network activity;

initiating a logical connection between the wireless local network and the terminal station; and

polling specific subscriber data of the wireless local network for the logical connection.

Claim 17. A method for connecting a wireless local network to a UMTS terminal station as claimed in claim 16, wherein a temporary status of at least one of the wireless local network and the specific subscriber data of the wireless local network is polled at periodic intervals.

Claim 18. A method for connecting a wireless local network to a UMTS terminal station as claimed in claim 16, wherein the specific subscriber data of the wireless local network includes a type/identity number, a subscriber identification, a password, a secret key for data encryption and decryption, and an address of an access node.

Claim 19. A method for connecting a wireless local network to a UMTS terminal station as claimed in claim 16, wherein the steps of monitoring and transmitting are initiated by a universal chip card installed in the terminal station.

Claim 20. A method for connecting a wireless local network to a UMTS terminal station as claimed in claim 19, wherein the terminal station notifies the universal chip card

of a deactivation of the wireless local network.

Claim 21. A method for connecting a wireless local network to a UMTS terminal station as claimed in claim 20, wherein the universal chip card initiates a cleardown of the logical connection between the wireless local network and the terminal station.

Claim 22. A method for connecting a wireless local network to a UMTS terminal station as claimed in claim 16, wherein the terminal station acknowledges all data transmitted.

Claim 23. A data system for connecting a wireless local network to a UMTS terminal station, comprising:

a wireless local network;

a UMTS terminal station having USIM/USAT functionality establishing a connection to the wireless local network;

parts for monitoring activity of the wireless local network using the established connection, wherein the parts for monitoring are contained in the terminal station;

parts for transmitting at least one of a type and an identity number of the wireless local network to the terminal station, the transmission occurring following successful detection of local network activity;

parts for initiating a logical connection between the wireless local network and the terminal station; and

parts for polling specific subscriber data of the wireless local network for the logical connection.

Claim 24. A data system for connecting a wireless local network to a UMTS terminal station as claimed in claim 23, wherein the terminal station polls a temporary status of at least one of the wireless local network and the specific subscriber data of the wireless local network at periodic intervals.

Claim 25. A data system for connecting a wireless local network to a UMTS

terminal station as claimed in claim 23, wherein the specific subscriber data includes a type/identity number, a subscriber identification, a password, a secret key for data encryption and decryption, and an address of an access node.

Claim 26. A data system for connecting a wireless local network to a UMTS terminal station as claimed in claim 23, wherein the terminal station further comprises a universal chip card which initiates the monitoring of the activity of the wireless local network and the transmission of data to the terminal station.

Claim 27. A data system for connecting a wireless local network to a UMTS terminal station as claimed in claim 26, wherein the terminal station notifies the universal chip card of a deactivation of the wireless local network.

Claim 28. A data system for connecting a wireless local network to a UMTS terminal station as claimed in claim 27, wherein the universal chip card initiates a cleardown of the logical connection between the wireless local network and the terminal station.

Claim 29. A data system for connecting a wireless local network to a UMTS terminal station as claimed in claim 23, wherein the terminal station acknowledges all data transmitted.

Claim 30. A UMTS terminal station having USIM/USAT functionality for establishing a connection to a wireless local network, comprising:

parts for monitoring activity of the wireless local network using an existing connection;

parts for initiating transmission of at least one of a type and an identity number of the wireless local network to the terminal station, the transmission occurring following successful detection of local network activity;

parts for initiating a logical connection between the wireless local network and the terminal station; and

parts for polling specific subscriber data of the wireless local network for the logical connection.

RELATED PROCEEDINGS APPENDIX

None.

EVIDENCE APPENDIX

EXHIBIT A: Final Office Action dated September 17, 2007

EXHIBIT B: Notice of Panel Decision from Pre-Appeal Brief Review dated February 15, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,345	03/10/2005	Mark Beckmann	112740-1051	6320

29177 7590 09/17/2007
BELL, BOYD & LLOYD, LLP
P.O. BOX 1135
CHICAGO, IL 60690

EXAMINER	
PATEL, NIMESH	
ART UNIT	**PAPER NUMBER**
2617	

MAIL DATE	DELIVERY MODE
09/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/522,345	BECKMANN ET AL.	
	Examiner	Art Unit	
	Nimesh Patel	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *Jul. 3, 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *16-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *16-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Detailed Office Action

Response to arguments

1. Applicant's arguments filed Jul. 3, 2007 have been fully considered but they are not persuasive.

Applicants argument stating on page 7 second paragraph of the remarks, that "Reddy fails to disclose that at least one of a type and an identity number of the wireless local network is transmitted to the terminal station following successful detection of local network activity"
is not persuasive.

The examiner respectfully disagrees, as
Reddy **inherently** discloses, after successful camping on a cell MS or UE receives system information. A communication link between the MS or UE 105 and a UTRAN node 120 is established, and system information is sent from the UTRAN node 120 to the MS or US 105 – S3A and S3B. Here, the system information needs to include **at least** the type of the wireless local network like, if the network is say CDMA, GSM, 3G, TDMA, along with the cell ID of the service provider cell and/or network ID that provides the service to the mobile, reads on the claimed feature, an identification number of the wireless local network (Figs. 1, 4/S10, 5/S16B, 6/S22B, and 7/S29B).

Applicants argument stating on page 7 last paragraph of the remarks that "Reddy fails to disclose the feature of initiating a local connection between the wireless local network and the terminal station",
is not persuasive.

The examiner respectfully disagrees, as
Reddy **inherently** discloses, in another embodiment, mobile unit 200 may simultaneously communicate with the cellular network 405 and the IP-based network 410. Alternatively, the mobile unit 200 may communicate with a wireless local area network – LAN, rather than IP-based network 410 (Fig. 4, paragraph 0031 - last 10 lines, and paragraph 0037 – first 5 lines).

Applicant's other arguments with respect to claims 16 - 30 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Claims rejection – 35 U.S.C. 112 2nd paragraph

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16 - 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant claims "polling specific subscriber data of the wireless local network" (in claims 16, 23 and 30), is this kind of downloading the data from the network specific to subscriber and stored at UICC? Say, the subscriber is roaming between different networks, and the NEW subscriber data needs to be downloaded for the new network.

The question is what happens after an UMTS terminal is polling data of the wireless local network?

Or is this subscriber data is polled from the UICC?

This makes the claim indefinite, as it is OPEN ENDED after polling the data from the network.

Claims Rejection – 35 U.S.C. 103(a)

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 16, 17, 19, 23, 24, 26, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Reddy, US PGPub: US 2004/0043791A1 Mar. 4, 2004, and in view of

Lin, US Patent: 6,078,811 Jun. 20, 2000.

Regarding claims 16, 23 and 30, which claims, "a wireless local network", Reddy discloses, a Wireless Local Area Network – WLAN (paragraphs 0031 and 0037, claims 20 and 23).

Further claimed feature, "a UMTS terminal station having USIM/SAT functionality", Reddy discloses, in 3rd Generation – 3G Universal Mobile Telecommunication Systems – UMTS, User Equipment – UE consists of Mobile Equipment – ME and a removable smart card called the UMTS Subscriber Identity Module – USIM (Fig. 1, and paragraphs 0003, 0004, 0006, 0007, 0015, 0016 and 0030).

Further claimed feature, "parts for monitoring activity of the wireless local network", Reddy discloses, when request to connect the MS 110 is received – S1, the PLMN and IMSI information is transferred from the USIM or SIM card 115 to the handset 110 for facilitating an initial cell search and to camp on the cell determined from the search – S2. After successful camping on a cell MS or UE receives system information. A communication link between the MS or UE 105 and a UTRAN node 120 is established, and system information is sent from the UTRAN node 120 to the MS or US 105 – S3A and S3B (Fig. 1). The handset has unique handset identity for transmitting, receiving and processing wireless communications. The handset selectivity transmits information to one or more networks for establishing a communication link with the networks.
Here, the handset is searching for cell, teaches the handset is monitors the network, and after successful searching, the handset receives system information, so the handset has claimed parts for monitoring activity of the wireless local network (paragraph 0016).

Further claimed feature, "after successful detection of local network activity, parts for transmitting **at least one** of a type and an identity number of the wireless local network **to** the terminal station", Reddy discloses, After successful camping on a cell MS or UE receives system information. A communication link between the MS or UE 105 and a UTRAN node 120 is established, and system information is

sent from the UTRAN node 120 to the MS or US 105 – S3A and S3B. Here, the system information needs to include **at least** the type of the wireless local network like, if the network is say CDMA, GSM, 3G, TDMA, along with the cell ID of the service provider cell and/or network ID that provides the service to the mobile, reads on the claimed feature, an identification number of the wireless local network (Figs. 1, 4/S10, 5/S16B, 6/S22B, and 7/S29B).

Further claimed feature, "parts for **initiating** a logical connection between the wireless local network and the terminal station", Reddy discloses, the handset 220 or UE 105 sends a connection request including the stored IMSI information to the Core Network 125 through UTRAN node 120 or with IP address (Figs. 4/S9 and S11, 5/S17, 6/S23, 7/S30). Here, the handset is initiating a logical connection between the handset and core network, through UTRAN Node 120. Here, Reddy teaches, once the mobile unit receives the system information, the mobile initiates the connection request with IP address and/or User information to UTRAN node 120,

but, is silent on, "using an existing connection" and "parts for polling specific subscriber data of the wireless local network for the logical connection".

Lin teaches, "using an existing connection", the existing mobile user U1 sends req_msg to VLR2 of the visiting network (Fig. 7, step s6.3, column 6, lines 13 – 49),

Lin further teaches, "parts for polling specific subscriber data of the wireless local network for the logical connection", the VLR2 requests profile of the mobile user U1 form the HLR. Here, the VLR2 is polling the specific subscriber data, which can include what kind of the wireless network systems the mobile subscriber can use, specific features that the mobile subscriber had accessed, reads on the claimed feature, polling specific subscriber data of the wireless local network for the logical connection (Fig. 7, steps s6.3 - s6.6, column 6, line 50 through column 7, line 11).

It would have been obvious to one of ordinary skill in the art, at the time of invention, to modify mobile unit having internet protocol functionality of Reddy, wherein, the handset with USIM card (Fig. 2/200), would have incorporated the handset (the handset sends request message to VLR2, and VLR2 polls the data from the HLR and passes on to the subscriber, polls specific subscriber data of the wireless local network (Lin, Fig. 7) of Lin, for the mobile station selectively transmits information to one or more networks for establishing a communication link with the network (Reddy, paragraph 0016).

Regarding claims 17 and 24, Reddy discloses all the claimed features,

but, is silent on, "polling a temporary status of at least one of the wireless local network and the specific subscriber data of wireless local network at periodic intervals".

Lin teaches, "parts for polling specific subscriber data of the wireless local network for the logical connection", the VLR2 requests profile of the mobile user U1 form the HLR. Here, the VLR2 is polling the specific subscriber data, which can include what kind of the wireless network systems the mobile subscriber can use; specific features that the mobile subscriber had accessed, reads on the claimed feature, polling specific subscriber data of the wireless local network is polled periodically. Here, the VLR2 itself stating for visiting location register, and it self explains that the information stored for status of wireless local network and the specific subscriber data is temporary, as once the mobile subscriber visits another VLR2, the information specific to the mobile subscriber is overwritten at the VLR2 (Fig. 7, steps s6.3 - s6.6, column 6, line 50 through column 7, line 11).

It would have been obvious to one of ordinary skill in the art, at the time of invention, to modify mobile unit having internet protocol functionality of Reddy, wherein, the handset with USIM card (Fig. 2/200), would have incorporated the handset (the handset sends request message to VLR2, and VLR2 polls the data

from the HLR and passes on to the subscriber, polls temporary specific subscriber data of the wireless local network (Lin, Fig. 7) of Lin, for the mobile station selectively transmits information to one or more networks for establishing a communication link with the network (Reddy, paragraph 0016).

Regarding claims 19 and 26, which claims, "the terminal station comprises a universal chip card which initiates the monitoring of the activity of the wireless local network and the transmission of data to the terminal station", Reddy discloses, in 3rd Generation – 3G Universal Mobile Telecommunication Systems – UMTS, User Equipment – UE consists of Mobile Equipment – ME and a removable smart card called the UMTS Subscriber Identity Module – USIM (Fig. 1, and paragraphs 0003, 0004, 0006, 0007, 0015, 0016 and 0030).

Reddy discloses, when request to connect the MS 110 is received – S1, the PLMN and IMSI information is transferred from the USIM or SIM card 115 to the handset 110 for facilitating an initial cell search and to camp on the cell determined from the search – S2. After successful camping on a cell MS or UE receives system information. A communication link between the MS or UE 105 and a UTRAN node 120 is established, and system information is sent from the UTRAN node 120 to the MS or US 105 – S3A and S3B (Fig. 1). The handset has unique handset identity for transmitting, receiving and processing wireless

communications. The handset selectivity transmits information to one or more networks for establishing a communication link with the networks.
Here, the handset is searching for cell, teaches the handset is monitors the network, and after successful searching, the handset receives system information, so the handset has claimed parts for monitoring activity of the wireless local network (paragraph 0016).

Claims 18, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reddy, US PGPub: US 2004/0043791A1 Mar. 4, 2004, and in view of
Lin, US Patent: 6,078,811 Jun. 20, 2000, and further in view of
Le, US Patent: US 6,556,820 Apr. 29, 2003.

Regarding claims 18 and 25, both Reddy and Lin, discloses all the claimed features,

but, are silent on, "the specific subscriber data includes a type/identity number, a subscriber identification, a password, a secret key for data encryption and decryption and an address of an access node".

Le teaches, the mobile can initiate a location update either on its own or on command from the network – periodic location update. The location areas are identified by Location Area Identification – LAC (column 9, lines 4 – 20). Each

cell has the cell identity – CI, which the network node broadcasts. Here, when it is initiated by the network command, which is the same as the claimed polling subscriber data of the wireless local network. The mobile station 110 consists of Mobile Equipment 124, and SIM 126 (Fig. 1, Fig. 9/930 – dual mode terminal), the SIM/USIM card 205 contains the International Mobile Subscriber Identity – IMSI, used to identify the subscriber to the system, a secret key for authentication and **other information** (column 6, lines 21 – 29).

Here, the other information can include the specific subscriber data, type/identity number, a subscriber identification, a password, a secret key for data encryption and decryption, and an address of an access node.

Le further teaches, handovers between UMTS and GSM (Fig. 9).

It would have been obvious to one of ordinary skill in the art, at the time of invention, to modify mobile unit having internet protocol functionality of Reddy and Lin, wherein, the handset with USIM card (combined Reddy and Lin, Fig. 2/200), the handset polls specific subscriber data of the wireless local network (Le, Figs. 1 and 2), and the mobile station can initiate update the subscriber location information or react on network command, for reducing a waste of processing load on the terminal and the various network nodes (Le, column 2, lines 54 – 58), for the mobile station selectively transmits information to one or more networks for establishing a communication link with the network (Reddy, paragraph 0016).

Claims 20 – 22, 27 - 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Reddy, US PGPub: US 2004/0043791A1 Mar. 4, 2004, and in view of

Lin, US Patent: 6,078,811 Jun. 20, 2000, and in further view of

3GPP TS 31.111 version 4.5.0 Release 4, 2001-12.

Regarding claims 20 and 27, Reddy and Lin discloses all the claimed features,

but, are silent on, "the terminal station notifys the universal chip card of a deactivation of the wireless local network".

The technical specification 3GPP TS 31.111 version 4.5.0 Release 4, Dec. 2001 teaches, once the ME has made its attempt to execute a proactive command from the UICC, the ME shall inform the UICC of the success or otherwise of that command, by using TERMINAL RESPONSE. This message gives the command details, including the number of command, a general result and sometimes more specific information (Section: 6.7). It also teaches, ME informs UICC for NO SERVICE is currently available, NO radio resource currently available, which reads on the claimed "the terminal station notifies the universal chip card of a deactivation of the wireless local network".

It would have been obvious to one of ordinary skill in the art, at the time of invention, to modify mobile unit having internet protocol functionality of Reddy, wherein, the handset with USIM card (combined Reddy and Lin, Fig. 2/200), for the mobile station selectively transmits information to one or more networks for establishing a communication link with the network (Reddy, paragraph 0016), and further notifying the status information to the universal chip card of the commands initiated by the universal chip card, for avoiding suspension of service provisioning to the user and to allow the ME access to the 3G functionality of the UICC if a USAT application is taking an unreasonable amount of time to complete execution (3GPP standard, section 6.1, lines 5 – 10).

Regarding claims 21 and 28, Reddy and Lin discloses all the claimed features,

but, are silent on, "the universal chip card initiates a cleardown of the logical connection between the wireless local network and the terminal station".

The technical specification 3GPP TS 31.111 version 4.5.0 Release 4, Dec. 2001 teaches, the UICC can issue variety of commands like DISPLAY TEXT, POLL INTERVAL, RECEIVE DATA, PROVIDE LOCAL INFORMATION, SEARVICE SEARCH, SET UP CALL – disconnecting all other calls and many more (section 6.1). Here, disconnecting call reads on the claimed "the universal chip card

initiates a cleardown of the logical connection between the wireless local network and the terminal station".

It would have been obvious to one of ordinary skill in the art, at the time of invention, to modify mobile unit having internet protocol functionality of Reddy, wherein, the handset with USIM card (combined Reddy and Lin, Fig. 2/200), and the mobile station selectively transmits information to one or more networks for establishing a communications link with the networks (Reddy, paragraph 0016), and further notifying the status information to the universal chip card of the commands initiated by the universal chip card, for avoiding suspension of service provisioning to the user and to allow the ME access to the 3G functionality of the UICC if a USAT application is taking an unreasonable amount of time to complete execution (3GPP standard, section 6.1, lines 5 – 10).

Regarding claims 22 and 29, Reddy and Lin discloses all the claimed features,

but, are silent on, "the terminal station acknowledges all data transmitted".

The technical specification 3GPP TS 31.111 version 4.5.0 Release 4, Dec. 2001 teaches, once the ME has made its attempt to execute a proactive command from the UICC, the ME shall inform the UICC of the success or otherwise of that command, by using TERMINAL RESPONSE. This message gives the command

details, including the number of command, a general result and sometimes more specific information (Section: 6.7). It also teaches, ME informs UICC for NO SERVICE is currently available, NO radio resource currently available, which reads on the claimed "the terminal station notifies the universal chip card of a deactivation of the wireless local network".

It would have been obvious to one of ordinary skill in the art, at the time of invention, to modify mobile unit having internet protocol functionality of Reddy, wherein, the handset with USIM card (combined Reddy and Lin, Fig. 2/200), and the mobile station selectively transmits information to one or more networks for establishing a communications link with the networks (Reddy, paragraph 0016), and further notifying the status information to the universal chip card of the commands initiated by the universal chip card, for avoiding suspension of service provisioning to the user and to allow the ME access to the 3G functionality of the UICC if a USAT application is taking an unreasonable amount of time to complete execution (3GPP standard, section 6.1, lines 5 – 10).

Contact Information

Any inquiry concerning this communication from the examiner should be directed to Nimesh Patel at (571) 270-1228, normally reached on Mon-Thur. 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rafael Perez can be reached on (571) 272-7915.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR of Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nimesh Patel
Sep. 11, 2007.

Rafael Perez-Gutierrez
Supervisory Patent Examiner
Technology Center 2600
Art Unit 2617
9/15/07

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,345	03/10/2005	Mark Beckmann	112740-1051	6320

29177 7590 02/15/2008

BELL, BOYD & LLOYD, LLP
P.O. BOX 1135
CHICAGO, IL 60690

EXAMINER	
PATEL, NIMESH	
ART UNIT	**PAPER NUMBER**
2617	

MAIL DATE	DELIVERY MODE
02/15/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Application Number	Application/Control No.	Applicant(s)/Patent under Reexamination	
	10/522,345	BECKMANN ET AL.	
	Rafael Pérez-Gutiérrez	Art Unit 2617	

Document Code - AP.PRE.DEC

Notice of Panel Decision from Pre-Appeal Brief Review

This is in response to the Pre-Appeal Brief Request for Review filed December 17, 2007.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

   ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
   ☐ The request does not include reasons why a review is appropriate.
   ☐ A proposed amendment is included with the Pre-Appeal Brief request.
   ☐ Other:

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☒ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

   ☒ The panel has determined the status of the claim(s) is as follows:
   Claim(s) allowed: ____.
   Claim(s) objected to: ____.
   Claim(s) rejected: *16-30*.
   Claim(s) withdrawn from consideration: ____.

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

Rafael Perez-Gutierrez
Supervisory Patent Examiner
Technology Center 2600
Art Unit 2617 2/12/08

All participants:

(1) *Rafael Pérez-Gutiérrez*.

(2) *Nimesh Patel*.

(3) *Wellington Chin*.

(4) ____.